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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Niraj VASISHT

Group Art Unit: 1711

Application No.: 10/654,422

Examiner: S. RAZA

Filed: September 4, 2003

Docket No.: 113631

For: MICROENCAPSULATION OF OXYGEN OR WATER SENSITIVE MATERIALS

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement mailed September 2, 2005, Applicants respond as follows.

The Office Action asserts a Restriction Requirement between Group I (claims 1-6), Group II (claims 7-20), and Group III (claims 21-49). In response, Applicants elect Group II, claims 7-20, with traverse. Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

I. Groups I and II

Applicants submit that Groups I and II should be examined together. The Restriction Requirement asserts that Groups I and II are distinct. Although Applicants agree that the inventions of Groups I and II may be independent or distinct as claimed, Applicants respectfully submit that the Restriction Requirement between Group I and Group II is improper, and should be withdrawn.

According to MPEP §803, there are ~~two~~ requirements that must be met before a proper Restriction Requirement may be made. These two requirements are: "The inventions must be

independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . " (emphasis added). Applicants respectfully submit that the Office Action has failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

Applicants respectfully submit that a search for the subject matter of Group II would be commensurate with a search for the subject matter of Group I. Accordingly, search and examination of the subject matter of Group II would encompass a search for the subject matter of Group I, and any additional search would not impose a serious burden upon the Examiner.

It is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). Because Applicants have elected Group II, directed to a microencapsulated material, the further search and examination of Group I, directed to a barrier coating composition, would not place a serious burden upon the Examiner.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement between Groups I and II be reconsidered and withdrawn.

II. Groups II and III

Applicants also submit that Groups II and III should be examined together.

Where product and process claims are presented in the same application, Applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Id.

In the present application, the method claims of Group III include all of the limitations of the product of Group II. In particular, all of the limitations of the independent product claim 7 of Group II are incorporated into the method of Group III.

Since the method claims of Group III include the limitations of the product claims of Group II, the method claims must be rejoined with the product claims once the product claims are allowed. Thus, to streamline prosecution and avoid delay, the Restriction Requirement should be withdrawn as between Groups II and III to permit concurrent examination of all of the pending claims. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

III. Conclusion

Early and favorable consideration of the application are respectfully requested. Should the Examiner have any questions regarding the application, or any suggestions to expedite prosecution, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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JAO:JSA

Date: September 15, 2005

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